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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

16356.823 (DC-05254)

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on February 5 2009Signature S. C. LienTyped or printed name Susan C. Lien

Application Number

10/675,396

Filed

September 30, 2003

First Named Inventor

Kwatra, Ajay

Art Unit

2111

Examiner

Daley, Christopher A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 26,528
☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

James R. Bell

Typed or printed name

512.867.8407

Telephone number

2.5.09

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	\$	
Kwatra, Ajay	\$	
	\$	Confirmation No.: 6485
Serial No.: 10/675,396	\$	
	\$	Group Art Unit: 2111
Filed: September 30, 2003	\$	
	\$	Examiner: Daley, Christopher Anthony
For: CHASSIS EXPANSION USING	\$	
NEWCARD	\$	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Responsive to the Final Office Action, dated November 5, 2008, please consider the following remarks in connection with the pre-appeal brief request for review.

The appropriate fee is being submitted and no additional fees are believed necessary for consideration of the present paper. However, if any additional fees, including extension of time fees, are necessary, the extension of time is hereby requested, and the Commissioner is hereby authorized to charge any fees to Haynes and Boone, LLP's Deposit Account No. 08-1394.

There is clear error in the rejection of claims 1, 4, 6-11, 14 and 16-22. The rejection does not support a prima facie case of obviousness as the Examiner has not properly considered the claimed power means.

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (U.S. Publication No. 2004/0260843) (Sleeman) in view of Saunders (Newcard Exposed) (Saunders), and further in view of Fischer et al (U.S. Patent No. 6,936,936) (Fischer).

A *prima facie* case of obviousness is missing at least because there is no support for an obviousness rejection of the claimed subject matter because the Examiner has not properly considered every element of the claims. Sleeman, Saunders and Fischer, alone or in combination, do not disclose every element of the claims. Therefore, the rejection is in clear error.

Independent claim 1 recites, in part:

A Newcard device to electrically couple a first and second subsystem of a computer...the Newcard device comprising...power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via powerline of the Newcard device.

The references, alone, or in any combination, do not teach the claimed power means, which includes two aspects: (1) a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and (2) the second subsystem deriving power from the computer via a powerline of the Newcard device.

In the Final Office Action, the Examiner states that Sleeman as modified by Saunders does not provide for the power means. See Office action dated November 5, 2008 at pg. 3. The Examiner instead asserts that Fischer provides the relevant functionality. Applicants submit that this assertion is in clear error.

Specifically, the Examiner asserts that Fischer provides for a power adapter to convert AC voltage to a plurality of voltages required by different components of the computer system. Final Office action dated November 5, 2008 at pg. 13. Even assuming this to be true, arguendo, this does not provide for the second subsystem receiving power from two places as claimed: (1) a power adapter and (2) from the computer via a powerline of the Newcard device.

The Examiner states in response to Applicants previous arguments of omission element (2) that:

"The NewCard, also known as ExpressCard, by definition, consists of two I/O buses (PCI-Express and USB), and power is supplied to the card by the host system via the PCI-Express and USB power interface/pins. Specifically, the Newcard draws 3.3 volts from the host via power interface of the PCI-E and/or USB power interface. For example, in case of USB power interface, a voltage supply is provided in a wire or 'line' as dictated by the USB specification. Thus, it is clear that power is derived from the computer system via a power line or wire of the NewCard consisting of two I/O buses, namely PCI-E bus and the USB bus."

Office action dated November 5, 2008 at pgs. 14 and 15; Advisory Action dated January 13, 2009 at pg. 2.

Even adopting, arguendo, the Examiner's position that a NewCard includes an industry standard bus (e.g., USB), and that that bus includes a wire that carries a voltage (e.g., 3.3V),

and that that bus draws power from a host, all the claim elements have not been properly considered. Specifically, the claim requires the second subsystem derive power from the computer via a powerline of the Newcard device. A second subsystem deriving power from a computer via a powerline of a card is clearly different than a disclosure that provides merely a voltage on a wire in a bus of the card. In other words, supplying power to a card is different than supplying power to a second subsystem via the card. The Examiner admits that the disclosure provides "power is supplied to the card by the host system." Office action dated November 5, 2008 at pg. 14, emphasis added. The Examiner does not assert, nor would the references disclose, providing power to the second subsystem via the card, which is the claim requirement. In summary, providing power to a card from a host does not disclose providing power to a second subsystem via a powerline of a card as claimed. To hold otherwise, is clear error.

Furthermore, the Examiner's assertions suffer from an additional error. The proposed combination of references cannot physically provide the Examiner's proposed combination. Therefore, it is clearly not indicative of predictable results. See MPEP 2143.01 (III). Fig. 2 of Sleeman is relied on by the Examiner as providing the computer and second subsystem. Fig. 2 is reproduced below for ease of reference.

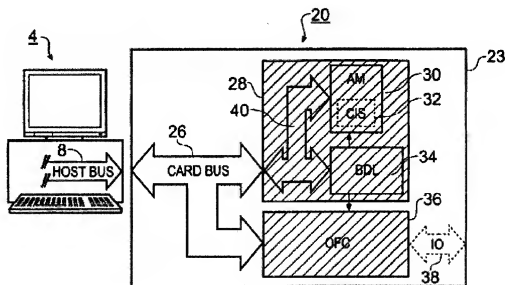


Fig. 2

Fig. 2 illustrates a PC-card 20 connected to a host computer 4. Sleeman [0028]. The PC-Card 20 includes a card bus 26 and an I/O connection 38. Sleeman also provides that "In this

example, the PC-card is a modem card and has input/output connectivity as schematically indicated by an I/O connection 38." Sleeman [0028].

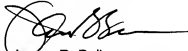
The Examiner appears to argue that the Newcard by definition includes USB and PCI-E buses and these buses include bus lines that carry a voltage. Office Action dated November 5, 2008 at pgs. 14 and 15. The Examiner the argues that it is this bus line that indicates the claimed power means. Fig. 2 clearly illustrates a card bus connecting to a host computer, but does not illustrate such a bus connected to a second subsystem. Therefore, in light of this configuration disclosed by Sleeman and relied upon by the Examiner, it is not a predictable result – or even feasible result – for power to be supplied from the host to a second system via the bus as asserted by the Examiner. The bus is not even connected to both a first (or host) and a second subsystem (see e.g., port 38 of Fig. 2, port 68 of Fig. 3). Furthermore, as described above Sleeman discloses the I/O connection (port 38 of Fig. 2, port 68 of Fig. 3) provides a modem connection. Sleeman at [0028]. A modem connection provides no suggestion or even indication of providing power to a second subsystem.

Independent claims 11 and 21 and their respective dependent claims include similar limitations are allowable for at least these reasons.

Other reasons for the patentability of the claims exist, including those previously presented, and will be maintained should the filing of an appeal brief become necessary.

Applicants further note that this is the same issue, though with reference to a different piece of prior art, that was before a panel in late 2007. A panel decision issued October 12, 2007 which reopened prosecution. The Examiner then cited to Fischer, it however suffers the same deficiency found by the previous panel.

Respectfully submitted,


James R. Bell
Registration No. 26,528

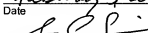
Dated: 2-5-09
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 300
Dallas, Texas 75219
Telephone: 512.867.8407
Facsimile: 214.200.0853
ipdocketing@haynesboone.com

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on

Date

February 5, 2009

Susan C. Lien